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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/759,558 | 01/16/2004 | Glen McLaughlin | PA2632US | 8129 |
| 22830 | 7590 | 06/05/2006 | EXAMINER | |
| CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303 | | | JAWORSKI, FRANCIS J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3768 | |

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 10/759,558 | Applicant(s) MCLAUGHLIN ET AL. | |
| | Examiner Jaworski Francis J. | Art Unit 3768 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44 - 71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/16/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Specification***

The specification is queried regarding its status as a 'continuation of US application 10/211,391 as the latter is a continuation-in-part of 10/039,922....variously stated in specification paras [0001 – 0006] insofar as the former application, now US 6,685,645 or the latter for example, now US 6,773,399 do not appear to mention many of the claimed features in the wordings of their specificity. See also below.

The amendment to the claims filed on June 21, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure by way of new claims 44 - 71.

35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Terminology, with emphasis to italicized terms :

Claims 44, 58 : '*transmission of at least two overlapping beams*'

'combining ..prior/subsequent to receive beamformation'

Claims 46, 60: '*partially focussed*'

Claims 47, 61: '*unfocused*'

Claims 48, 62: '*azimuth*'

Claims 49, 63: '*azimuth angle*'

Claims 50, 64: '*combination of azimuth and azimuth angle*'

Claims 51, 65: '*elevation*'

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Claims 52, 66: 'elevation angle'

Claims 55, 69: '*adjusting* magnitude and phase...*directly*'

Claims 56, 70: '*linear* transformation' meaning 'any linear transform' in the generic sense.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 44 –71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, vide supra.

Action Summary

Whereas the original claim set filed January 16, 2004 in this case had independent claims and a claim set 1 – 43 which generally tracked the content of the

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inventive objects of the parent case US6685645, those claims were cancelled via preliminary amendment filed June 21, 2004 in favor of new independent claims/claim set 44 – 71 claiming features with wordings which apparently do not literally appear in this patent or in its ancestral documents. A preliminary amendment filed after the filing date may of course not add new material to the disclosure. It is possible that the preliminary amendment was intended for a different filing. If it was not then the applicants are kindly requested to reconcile the listed terminologies with specification portions and figure numbers so that the Examiner is assured that adequate support for these features exists in this application and is able to proceed with further examination with a concise understanding of these seemingly unexplained features.

[Alternately stated, at this juncture the Examiner searched the mentioned claims' terms against a reference set consisting of the mentioned two patents and alternatively of a set consisting of a Zonare- assigned broadbeam patent subset including issuances from applications cited in this specification and was unable to achieve a match, leaving open the possibility that a related case filing unassociated with an issued patent or pre-grant publication in the database might match, or that additional subject matter might have in fact been inadvertently added after the filing date in this case, pending a reconciling of terms by the applicants.]

Any inquiry concerning this communication should be directed to Jaworski Francis J. at telephone number 571-272-4738.

FJJ:fjj

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Francis J. Jaworski
Primary Examiner